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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,502	09/19/2005	Jean-Pierre Catinat	271729US0PCT	5037

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

MABRY, JOHN

ART UNIT	PAPER NUMBER
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1625

NOTIFICATION DATE	DELIVERY MODE
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02/06/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/534,502

Applicant(s)

CATINAT ET AL.

Examiner

John Mabry, PhD

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner's Response

Applicant's response on November 9, 2007 filed in response to the Office Action dated August 9, 2007 has been received and duly noted. In view of this response, the status of the rejection/objections of record are as follows:

35 USC § 112

The 112-2nd rejection regarding claims 11-20 have been overcome in view of Applicant's arguments and amendments of the claims.

Obviousness-Type Double Patenting

The obviousness-type double patenting rejected has not been overcome over US 2006/0167288 A1 (10/534,299) in view of Gilbeau (US 6,063,941). The Examiner is not persuaded by Applicant's argument. Applicant stated in response to Office Action (dated November 9, 2007) that Gilbeau (US 6,063,941) does not address the deficiency noted in US 2006/0167288 A1. However, the Examiner re-asserts that it would be routine experimentation for an artisan of ordinary skill to modify the pH in order to determine optimum range.

35 USC § 103(a)

Applicant's arguments, see page 6 of Applicants remarks, filed November 9, 2007, with respect to the rejection(s) of claim(s) 11-20 under 35 U.S.C. 103(a) as being unpatentable over Gilbeau (US 6,063,941) in view of De Jong et al. (WO 96/03362) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

Applicant's arguments filed November 9, 2007 have been fully considered but they are not persuasive, with respect to the rejection(s) of claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Strebelle et al (US 6,288,248) in view of Nakanishi et al (JP 04327582) in further view of Gilbeau (US 6,063,941).

The Applicants argue that Strebelle and Nakanishi are not combinable. The Examiner respectfully disagrees. Strebelle and Nakanishi teach the importance of obtaining a epichlorohydrin with reduced impurities content (see column 1 of Strebelle and paragraph 4 of Nakanishi). Although Strebelle et al focus more on removing chloro impurities, the object of Strebelle et al. is to obtain a purer epichlorohydrin product (see paragraph 4). The skilled artisan would have been motivated to utilize any means by which to do so, including the use of allyl chloride starting material which contains less than or equal to 0.1wt% of 1,5-hexadiene, as taught by Nakanishi. The use of a combination of the teaching of Strebelle with that of Nakanishi would allow the skilled artisan to obtain an even purer epichlorohydrin product. As stated in previous Office

Action (dated August 9, 2007), Gilbeau describes that it is advantageous to control acidity of said process at a pH range, preferably, 2 to 8 (see entire disclosure in particular column 3, lines 34-53).

The Applicants arguments with respect to additional examples and reference to examples in Specification have been considered but the examiner believes that the prior art references when combined would give one an easy method for obtaining high purity epichlorohydrin product that would inherently overcome the reduced catalyst life problem relied upon by Applicants for patentability. Granting a patent on the discovery of an unknown but inherent function would re-move from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art. For the above reasons the rejection of 11-20 is maintained.

Additionally, claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strebel et al (US 6,288,248) in view of Nakanishi et al (JP 04327582) in further view of Gilbeau (US 6,063,941) in references mentioned above. The adjustment of particular conventional working conditions (e.g. determining result effective amounts of the ingredients beneficially taught by the cited references, especially within the ranges instantly claimed such as pH range used), as well as adjustment of reaction temperature, reaction time and use of solvents or absence thereof, is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan (*In re* Mostovych, Weber, Mitchell and

Aulbach, 144 USPQ 38). Accordingly, these types of modifications would have been well within the purview of the skilled artisan and no more than an effort to optimize results.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

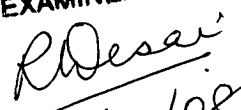
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



JM

RITA DESAI
PRIMARY EXAMINER


11/31/08